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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,680	02/07/2001	Isao Okawa	Q62866	3339

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SUGHRUE, MION, ZINN  
MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 05/14/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/777,680

Applicant(s)

OKAWA ET AL.

Examiner

Victor Lesniewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4,5, and 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This application has been examined.
2. Claims 1-32 are now pending.

***Information Disclosure Statement***

3. The IDS filed on 2/7/2001 (Paper #4), the IDS filed on 12/31/2002 (Paper #5), and the IDS filed on 9/17/2003 (Paper #6) have been considered.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 11, 12, 23, 24, 27, 28, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by DeSimone et al. (U.S. Patent Number 6,212,548), hereinafter referred to as DeSimone.
6. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a method or recording medium are rejected under the same rationale applied to the described claim.
7. DeSimone has disclosed:

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- <Claims 11, 27, and 31>

A communication system comprising a server device and a plurality of client devices connected through a network and allowing mutual communications among users of the client devices (column 4, lines 39-56), the server device having: a profile storing unit which stores first identification information preliminarily given to the user for identifying the user in the network, second identification information preliminarily given to the user for identifying the user in the communication system, and permit information relating to approval or disapproval of use of the service to the user, being the information stored at least corresponding to the first identification information (column 15, lines 20-27); and a validation processing unit which extracts the permit information corresponding to the first identification information from the profile storing unit when the first identification information and second identification information are presented from the client device and use of specific service is requested, and judges approval or disapproval of presentation of service to the client device on the basis of this permit information and the request for use presented from the client device (column 15, lines 28-36).

- <Claims 12, 28, and 32>

A communication system comprising a server device and a plurality of client devices connected through a network and allowing mutual communications among users of the client devices (column 4, lines 39-56), the server device having: a profile storing unit which stores first identification information preliminarily given to the user for identifying the user in the communication system, and an arbitrary handle name of the user, by relating to each other (column 5, lines 40-54); and an ID converting unit which extracts

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the handle name corresponding to the identification information from the profile storing unit when the identification information is presented from one client device and use of specific service relating to other client device is requested, and converts the identification information depending on this handle name (column 6, lines 57-64).

- <Claim 23>

A server device connected to plural client devices through a network for allowing mutual communications among users of these client devices (column 4, lines 39-56), the server device comprising: a profile storing unit which stores first identification information preliminarily given to the user for identifying the user in the network, second identification information preliminarily given to the user for identifying the user in the communication system, and permit information relating to approval or disapproval of use of the service to the user, being the information stored at least corresponding to the first identification information (column 15, lines 20-27); and a validation processing unit which extracts the permit information corresponding to the first identification information from the profile storing unit when the first identification information and second identification information are presented from the client device and use of specific service is requested, and judges approval or disapproval of presentation of service to the client device on the basis of this permit information and the request for use presented from the client device (column 15, lines 28-36).

- <Claim 24>

A server device connected to plural client devices through a network for allowing mutual communications among users of these client devices (column 4, lines 39-56), the server

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device comprising: a profile storing unit which stores first identification information preliminarily given to the user for identifying the user in the communication system, and an arbitrary handle name of the user, by relating to each other (column 5, lines 40-54); and an ID converting unit which extracts the handle name corresponding to the identification information from the profile storing unit when the identification information is presented from one client device and use of specific service relating to other client device is requested, and converts the identification information depending on this handle name (column 6, lines 57-64).

Since all the limitations of the invention as broadly set forth in claims 11, 12, 23, 24, 27, 28, 31, and 32 were disclosed by DeSimone, claims 11, 12, 23, 24, 27, 28, 31, and 32 are rejected.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 6-9, 13-16, 18-21, 25, 26, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone in view of Grimm et al. (U.S. Patent Number 5,828,843), hereinafter referred to as Grimm.

10. DeSimone disclosed a client-server message processing environment where a plurality of users communicate in a plurality of real-time text conversations. In an analogous art, Grimm disclosed a network match making system for matching users of a multi-user networked

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application. He explicitly points out that an example of such an application is an online chat environment. See column 1, lines 17-20. It is evident that Grimm's match making system is meant to function in an environment such as that of DeSimone's invention.

11. Although DeSimone did not explicitly state that his system could automatically match users based on client attributes, Grimm taught a network match making system that would accomplish this. Since the inventions could readily be used together as noted above, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system provided by DeSimone by adding the match making capabilities as provided by Grimm. This would strengthen DeSimone's chat environment by efficiently bringing together groups of users. See Grimm, *inter alia*, column 1, lines 20-23.

12. Thereby, the combination of DeSimone and Grimm discloses:

- <Claims 1, 25, and 29>

A communication system comprising a server device and a plurality of client devices connected through a network and allowing mutual communications among users of the client devices (DeSimone, column 4, lines 39-56), the server device having: a matching unit which selects a candidate user for participant in a chat according to a specified standard, and transmits the information about this user to a client device (Grimm, column 2, lines 1-9); and a chat processing unit which transmits specified information for starting a chat, when start of a chat is requested by specifying whole or part of users selected by the user selecting unit from one client device, to the client device of this specified user, and the one client device issuing this request (DeSimone, column 6, line 40 through column 8, line 57), and each of the client device having a display unit which displays the

region for chat on the basis of the specified information when this information for starting a chat is transmitted from the server device (DeSimone, column 6, line 40 through column 8, line 57).

- <Claim 2>

The communication system according to claim 1, wherein the matching unit of the server device selects the user of other client devices to which the same information is transmitted in the last place, concerning the information transmitted in the last place to each client device, among the users of the client devices of which connection is established at the present (Grimm, column 3, lines 45-53).

- <Claim 3>

The communication system according to claim 1, wherein the matching unit of the sever device selects the user preliminarily registered as having specific relation by the users of each client device, among the users of the client devices of which connection is established at the present (DeSimone, column 14, line 62 through column 15, line 1).

- <Claim 4>

The communication system according to claim 1, wherein the matching unit of the sever device arrays or stratifies the selected users according to a specified standard (DeSimone, column 5, lines 15-27).

- <Claims 6, 26, and 30>

A communication system comprising a server device and a plurality of client devices connected through a network and allowing mutual communications among users of the client devices (DeSimone, column 4, lines 39-56), the server device having: a matching



unit which selects a candidate user for destination of transmission of message according to a specified standard, and transmits the information about this user to a client device (Grimm, column 2, lines 1-9); and a message processing unit which transmits the content of the message to the client device of the specified user, when message transmission is requested by specifying whole or part of users selected by the user selecting unit from one client device, and when the content of the message is specified (DeSimone, column 6, line 40 through column 8, line 57), and each of the client device having an output unit which issues a specified output, when the content of the message is transmitted from the server device, so that at least its presence may be recognized by the user of the client device (DeSimone, column 6, line 40 through column 8, line 57).

- <Claim 7>

The communication system according to claim 6, wherein the matching unit of the server device selects the user of other client devices to which the same information is transmitted in the last place, concerning the information transmitted in the last place to each client device, among the users of the client devices of which connection is established at the present (Grimm, column 3, lines 45-53).

- <Claim 8>

The communication system according to claim 6, wherein the matching unit of the sever device selects the user preliminarily registered as having specific relation by the users of each client device, among the users of the client devices of which connection is established at the present (DeSimone, column 14, line 62 through column 15, line 1).

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- <Claim 9>

The communication system according to claim 6, wherein the matching unit of the sever device arrays or stratifies the selected users according to a specified standard (DeSimone, column 5, lines 15-27).

- <Claim 13>

A server device connected to plural client devices through a network for allowing mutual communications among users of these client devices (DeSimone, column 4, lines 39-56), the server device comprising: a matching unit which selects a candidate user for participant in a chat according to a specified standard, and transmits the information about this user to a client device (Grimm, column 2, lines 1-9); and a chat processing unit which transmits specified information for starting a chat, when start of a chat is requested by specifying whole or part of users selected by the user selecting unit from one client device, to the client device of this specified user, and the one client device issuing this request (DeSimone, column 6, line 40 through column 8, line 57).

- <Claim 14>

The server device according to claim 13, wherein the matching unit selects the user of other client devices to which the same information is transmitted in the last place, concerning the information transmitted in the last place to each client device, among the users of the client devices of which connection is established at the present (Grimm, column 3, lines 45-53).

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- <Claim 15>

The server device according to claim 13, wherein the matching unit selects the user preliminarily registered as having specific relation by the users of each client device, among the users of the client devices of which connection is established at the present (DeSimone, column 14, line 62 through column 15, line 1).

- <Claim 16>

The server device according to claim 13, wherein the matching unit arrays or stratifies the selected users according to a specified standard (DeSimone, column 5, lines 15-27).

- <Claim 18>

A server device connected to plural client devices through a network for allowing mutual communications among users of these client devices (DeSimone, column 4, lines 39-56), the server device comprising: a matching unit which selects a candidate user for destination of transmission of message according to a specified standard, and transmits the information about this user to a client device (Grimm, column 2, lines 1-9); and a message processing unit which transmits the content of the message to the client device of the specified user, when message transmission is requested by specifying whole or part of users selected by the user selecting unit from one client device, and when the content of the message is specified (DeSimone, column 6, line 40 through column 8, line 57).

- <Claim 19>

The server device according to claim 18, wherein the matching unit selects the user of other client devices to which the same information is transmitted in the last place, concerning the information transmitted in the last place to each client device, among the

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users of the client devices of which connection is established at the present (Grimm, column 3, lines 45-53).

- <Claim 20>

The server device according to claim 18, wherein the matching unit selects the user preliminarily registered as having specific relation by the users of each client device, among the users of the client devices of which connection is established at the present (DeSimone, column 14, line 62 through column 15, line 1).

- <Claim 21>

The server device according to claim 18, wherein the matching unit arrays or stratifies the selected users according to a specified standard (DeSimone, column 5, lines 15-27).

Since the combination of DeSimone and Grimm discloses all of the above limitations, claims 1-4, 6-9, 13-16, 18-21, 25, 26, 29, and 30 are rejected.

13. Claims 5, 10, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of DeSimone and Grimm, as applied above, in view of Morris et al. (U.S. Patent Number 6,496,851), hereinafter referred to as Morris.

14. The combination of DeSimone and Grimm disclosed a client-server message processing environment that could automatically match users. In an analogous art, Morris disclosed a similar system for an online chat. His system allows users to agree on a mutually acceptable communication ahead of time. See column 3, lines 36-42.

15. Although the combination of DeSimone and Grimm did not explicitly state that the system could reject a request for communication, Morris taught a system which could make

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rejections. Since the inventions encompass the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of DeSimone and Grimm by adding the ability to reject requests as provided by Morris. This would make sense since Morris's invention would allow for a smoother chatting environment.

16. Thereby, the combination of DeSimone, Grimm, and Morris discloses:

- <Claim 5>

The communication system according to claim 1, wherein the server device further comprises a validation processing unit which rejects request of a specific processing, when a specific processing is requested from one client device to other client device, if the user of the one client device has been already registered as having a specific relation by the user of the other client device (Morris, column 4, lines 35-41).

- <Claim 10>

The communication system according to claim 6, wherein the server device further comprises a validation processing unit which rejects request of a specific processing, when a specific processing is requested from one client device to other client device, if the user of the one client device has been already registered as having a specific relation by the user of the other client device (Morris, column 4, lines 35-41).

- <Claim 17>

The server device according to claim 13 further comprising a validation processing unit which rejects request of a specific processing, when a specific processing is requested from one client device to other client device, if the user of the one client device has been

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already registered as having a specific relation by the user of the other client device

(Morris, column 4, lines 35-41).

- <Claim 22>

The server device according to claim 18 further comprising a validation processing unit which rejects request of a specific processing, when a specific processing is requested from one client device to other client device, if the user of the one client device has been already registered as having a specific relation by the user of the other client device

(Morris, column 4, lines 35-41).

Since the combination of DeSimone, Grimm, and Morris discloses all of the above limitations, claims 5, 10, 17, and 22 are rejected.

### *Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

- Aggarwal et al. (U.S. Patent Number 5,943,478) disclosed a system for sending immediate popup messages between internet users.
- Gutfreund et al. (U.S. Patent Number 6,192,394) disclosed an out-of-band mechanism allowing a user of an internet chat program to send invitations to other users.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 703-308-6165.

The examiner can normally be reached on Monday through Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor Lesniewski  
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